MOTION FILED

JUL 19 1984

83-2084

IN THE SUPREME COURT OF THE
UNITED STATES OF AMERICA
OCTOBER TERM, 1983

LESLIE C. CASE,
Petitioner,

vs.

CPC INTERNATIONAL, INC. and

COMMISSIONER OF PATENTS AND TRADEMARKS
Respondents,

IN SUPPORT OF
PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE AND BRIEF OF WENDELL S. MILLER AMICUS CURIAE, PRO SE.

WENDELL S. MILLER, Patent agent
as Amicus Pro Se

July 18, 1984 (Reformated)

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MOTION

Amicus Curiae, Wendell S. Miller, moves for leave to file a brief om behalf of the jurisdictional statement of Petitioner Leslie C. Case for a Writ of Certiorari to the Court of Appeals for the Federal Circuit. The offered brief accompanies this motion.

Amicus was very recently informed of this present posture of his case by Dr. Case in order that such a brief as this might be submitted were that desired.(consent obtained)

Amicus has contacted counsel for Respondent, CPC, International, Inc. by phone and has been informed that duty to his client dictates that he cannot approve a request to submit this brief.(consent not obtained)

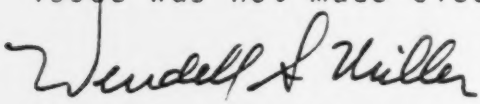
Amicus is acting solely on his own behalf and has no personal or professional connection with Petitioner Case or Respondent, CPC International or its counsel. He is, however, a Registered Patent Agent, #20,358 and, in practice before the Office of Respondent,(consent not obtained)

Commissioner of Patents and Trademarks, has a vital and continuing interest in the correct statement of the patent law. Amicus has been involved with patent interferences and their sequels since 1967 and has a comprehension of the nuances of interference law and practice.

In the instant case, there is an important principle of the law related to interferences which has been misstated and misapplied by the court, no doubt in response to the form of advocacy which Dr. Case's brief displays. The Petitioner, acting pro se, has appreciated that there is a fundamental error in the successive decisions in this matter by Examiner, Board and Courts. From the reported decisions, it appears that he has adequately stated the essential facts and, perhaps indistinctly, pointed to the law. However, he has allowed the main point to become obscured by a welter of extraneous issues.

The public will be bound through stare decisis by the law stated below. In fairness

to its right to a correct statement, Amicus requests that his brief be considered lest the public be permitted to suffer because this action was so prosecuted that the important issue was not made clear to the court.



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CITATIONS

CASES

Case v. Commissioner of Patents and Trademarks

U. S. Supreme Court Docket 75-1566 (Appended hereto) p.9

Case v. CPC International, Inc.

730 F2d 745, 221 USPQ 196 p.1

McCormick Harvesting Machine Co. v. Aultman

169 US 606, 18 SCt 443, 42 LEd 875 p.9

Tofe v. Winchell

645 F2d 60, 209 USPQ 379 p.7

STATUTES

35 USC 135 p.4

35 USC 185 p.8

RULES AND INSTRUCTIONS

37 CFR §1.131 p. 6

37 CFR §1.231(a)(1) p.6

37 CFR §1.205(a) p.5

Manual of Patent Examining Procedure §1101.02 II(b) p.3

The decision of the Court of Appeals for the Federal Circuit (CAFC) in this case contains the statement:

> No purpose would be served in determining patentability of the count itself over prior art, particularily a phantom count, which by definition neither party asserts as a claim.
> 730 F2d 745, 749; 221 USPQ 196,199

This statement is erroneous in failing to appreciate the significance of the count being patentable over prior art. If uncorrected, it will unnecessarily destabilize an important area of patent practice already mired in a welter of confusing precepts. It results in a wrong decision in this case. An illustrative example below will show the nature of the problem.

A patent interference is a proceeding before the Board of Patent Interferences (BPO) of the Patent and Trademark Office (PTO) to determine which of two or more inventors is entitled to be considered amongst them as the first inventor de jure.

It is not to determine other aspects of patentability of any invention to anyone except as such may be necessary to accomplish this specific object. The CAFC has focused on the first half of the preceeding sentence and ignored the emphasised second half. The aspects of patentability which must be so considered are termed "ancillary to priority". A slavish attention to specific catagories of aspects which have been so dubbed, without application of the above emphasised criterion, leads to much wasteful strife and injustice.

PHANTOM COUNT PRACTICE

In "Phantom Count' practice, here involved, the issue is expressed as a count in which various limitations appearing in the claims of each of the parties are omitted. Such count is thus broader than any claim which can be made by any of the parties and indeed is unpatentable to each of them as none presumably has disclosed

an invention of such broad scope—had one, the count need not be a phantom.

However, as specifically stated at §1101.02 II(b) of the PTO Manual of Patent Examining Procedure: "Further, such a 'phantom' count must be patentable over the prior art." An example, closely analogous to that of this case, shows why this must be so.

Assume that there is as prior art a product, "rubber vulcanized with 5 to 10 units of sulfur, suitable for tire tread." Assume also that party A invents a product, "rubber vulcanized with 40 to 50 units of sulfur, suitable for bowling balls; and that then party B invents and patents a product, "rubber vulcanized with 1 to 2 units of sulfur, suitable for surgeons gloves." Each of these inventions may be separately patentable at least in its own range of limitation.

Let the party A, after seeing B's

claim published, copy that claim and through persuasive advocacy procure the Primary Examiner to declare an interference with B. The count would need be a "phantom" calling for "rubber vulcanized with 1 to 50 parts sulfur", so that it cover both A and B.

Under these assumptions and the law as stated now by the CAFC, A would be ruled the "prior inventor" of the count between A and B, and B would be divested of his proper patent right. A could not receive a patent on B's invention; he neither invented nor disclosed it. However, A would have achieved freedom to practice B's invention without paying royalty.

The reason for such an anomaly is that this phantom count is not patentable over the prior art. There is thus a crucial purpose to "be served in determining patentability of the count over prior art".

Specifically, the statutory authorization, 35 USC 135, to the extent it

speaks, contemplates an interference where the inventions claimed are the "same or substantially the same subject matter". Rule, 37 CFR §1.205(a), effects this by permitting as counts "claims excluding an immaterial limitation or variation".

To have an interference declared, each party's respective claims must first be found patentable in their respective applications or patents except for the mutual issue of priority. If a count is synthesized from these patentable claims by suppression of some limitation, and such new count is then not patentable over the prior art, the suppressed limitation could not have been "immaterial". This conclusion applies to any count with suppressed limitations, not just to "phantoms."

In the present case, the District Court correctly stated the law as far as it went, but did not reach the crucial factual allegation of invalidity of the count over

the prior art. The CAFC on the other hand, preceived that factual allegation but then by misstating the law, denied its own jurisdiction and that of the District Court and the BPI to address the issue.

Under this ruling, the determination of the materiality of the deleted limitation is left to the Primary Examiner alone. That occurs ex parte with the claim copier, the party in A's position in the example above. If B is a patentee, A will have had access to B's entire patent file including any of his priority date assertions in 37 CFR §1.131 affidavits. A further will have had the opportunity for ex parte interviews with the examiner to argue his views and present evidence. B, however, never has a right to present "affidavits, declarations or evidence outside of official records and printed publications". 37 CFR §1.231(a)(1). He has no right to an oral hearing corresponding to A's interview, and there is review by no

other officer, board or court. This dissymetry or right is a far cry from fairness or any concept of due process, especially when it is the patentee with a vested right that is the one deprived. This is not an abstract possibility. It is exemplified in the present case.

JURISDICTION

The CAFC further elliptically cites the remarks of Chief Judge Markey, concurring, in Tofe v. Winchell 645 F2d at 64, 209 USPQ at 385, listing issues that have been held to be ancillary to priority. That citation states farther on:

> Whether an application is defective is critical, not just ancillary, to the right to a patent. It may also be viewed as involved in the requirement that there be at least two applications (or an application and a patent) available for interference, that is as going to the jurisdiction of the board. Thus defects in the application relate to or are "ancillary" to, the question of who was the first to make the invention.
>
> The defects refered to are not

invalidity over prior art and the like. an application may be unpatentable for such a reason without being defective. "Defects" rather are such matters as abandonment of invention by virtue of 35 USC §185, fraud in prosecution, failure to make the oath or to pay the fees or to include an essential part of the specification or claims.

There may be some reason to determine priority between parties when there is an early, provable actual reduction to practice, though it is doubtful interference is the proper way when neither party can be eligible to obtain a patent. However, in a case such as this where the "date of invention" is determined by the date of filing of a complete application (constructive reduction to practice) the threshold question is clearly patentability of the count in the sense of completeness and propriety of prosecution of the affected applications.

A definitive statement of this principle is sorely needed to cut through the present fog of decisions.

In an earlier motion to this Court, Case v. Commissioner of the Patent and Trademark Office, Motion for Leave to File Petition for Writ of Mandamus, 75-1566, the present petitioner sought a writ of mandamus to compel the Commissioner of the PTO to inquire into asserted aspects of fraud in his Office as related to the prosecution of his opponents application. In the Opposition to his request filed on behalf of the PTO, the government denied that the Commissioner had any mandatory duty to inquire into fraud alledged to be being practiced at his Office. (antepenultimate par.)

The patent community shook its head cynically at such an allegation which denies a basic duty of any department head and goes squarely against the dictum of this Court in

McCormick Harvesting Mach. Co. v. Aultman

> Had the original patent been procured by fraud or deception, it would have been the duty of the Commissioner of Patents to have had the matter referred to the Attorney General with a recommendation that a suit be instituted to cancel the patent.
> 169 US 606, 18 SCt 443, 42 LEd 875

The Commissioner's denial of such a duty shows the extreme need for a clear instruction to the PTO to take action on fraud as the "threshold" question in any of its deliberations wherein it is properly raised. It is better to scotch fraud at its first appearance before other proceedings are wastfully conducted than to allow it to do its damage to the rights of others and to the confidence of the public in the patent system.

Wendell S. Miller

mandamus to compel the Commissioner to grant petitioner's motion to take interrogatories and to take notice of the alleged discrepancies. The district court dismissed the action (Pet. 8). The court of appeals affirmed, on the ground that petitioner's complaint, although framed in terms of mandamus, sought judicial review of an interlocutory decision of the Patent Office (Pet. App.).

2. The court of appeals correctly affirmed the dismissal of this action. Although 35 U.S.C. 146 gives the district courts jurisdiction to review final decisions of the board of patent interferences on questions of priority, it does not authorize review of interlocutory decisions of the board. Cf. *Sanford* v. *Kepner*, 344 U.S. 13; *Phillips Petroleum Company* v. *Brenner*, 383 F.2d 514 (C.A.D.C.). As petitioner concedes (Pet. 11), the interference proceeding at issue has not yet been terminated, and the board has issued no final decision on priority. Accordingly, the district court was without jurisdiction.

In any event, neither the board nor the Commissioner has a mandatory duty to require interrogatories in a patent interference proceeding, or to investigate charges of fraud.[1] Accordingly, mandamus will not lie.

[1] *Precision Instrument Manufacturing Company* v. *Automotive Maintenance Machinery Co.*, 324 U.S. 806, upon which petitioner relies, is inapposite, since the Court held there only that the failure of a party to Patent Office proceedings to report to the Office all facts concerning possible fraud underlying the applications at issue barred that party from seeking equitable relief in a subsequent suit for infringement of the patent.

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